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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,877	04/04/2001	Takafumi Soramoto	P 280041 VN-0071US	1841

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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/824,877	Applicant(s) SORAMOTO ET AL.	
	Examiner Yogesh C. Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/4/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/6/2007 has been entered.

Response to Amendment

2. Applicant's amendment received on 3/6/2007 is acknowledged and entered. Claims 37-38 are currently amended. New claim 39 is added.

Election/Restrictions

3. Newly submitted claim 39 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 39 recites the step of comprising a judging unit for judging from the information read by the reading unit whether the web page from which the user terminal has jumped is the compensation-providing portal site or not and this represents a different specie other than elected by the applicant on 3/7/2005 without traverse. Different steps of judging belonged to non-elected species of claims 7&18, 8 &19, 9 & 20, and 35. Further, this limitation of judging

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if the user terminal has jumped from the compensation providing portal site is a new specie.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 39 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Therefore, currently claims 37-38 are pending for further examination.

Response to Arguments

4.1 The examiner agrees to the applicant's arguments that with the current amendments to claim 37 it produces a useful, concrete, and tangible result. As such rejection of claim 38 under 35 USC 101 is withdrawn. Since in the currently amended system claim 37 the limitation, " wherein said server...processes information ... database....database...according to executable instructions stored in a CPU, ROM m and /or RAM", is taken out it is still subject to rejection under 35 USC 101 because the currently amended limitations represent disembodied data structure.

4.2. Applicant's arguments with respect to prior art rejection of claims 37-38 have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendment.

4.3. Applicant's arguments regarding newly added claim 39 that it belongs to the same specie as that of claims 37-38 are not persuasive as analyzed above in paragraph 3 above.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 37 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

Limitations of claim 37 are directed to disembodied data structure claim which are per se not statutory. C.f. In re Wamerdam. The preamble of the independent claim 37 and all its limitations are directed to a server comprising rewriting unit, different databases and a compensating granting unit which all represent mere computer software/code. Mere software/code is not capable of functioning until it is stored in a computer readable medium and executed by a computer processor. **A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application resulting in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101.** See U.S. Patent 5,710,578 to Beauregard etc. i.e., **a set of instructions in combination with a computer system.** C.f. In re Wamerdam - data structure stored in a computer memory, and In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium. Examples of Statutory Functional Descriptive Material are:

(a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.

(b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer

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itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palcic et al. (US Publication 2003/0004809A1), hereinafter Palcic further in view of Lee et al. (US Publication 20020161673A1), hereinafter Lee.

Regarding claim 37, Palcic in view of Lee discloses a server for a compensation-granting portal site on the Internet having a first URL, and connecting to a plurality of other servers through the Internet through a user terminal, the server comprising:

a compensation-granting database configured to store URL information of each member store in advance (see Palcic paragraph 0067, "...Elements of the portal page will include links to company pages 140....". Links refer to URL information of merchant's web pages/sites are stored. These links are provided to users requesting/selecting these merchants to place orders, see paragraph 0068.). ;

Palcic teaches transmitting the stored merchant's link, that is URL to the merchant's web page, to the user terminal on his request but does not teach rewriting this URL [second as the first URL belongs to the portal web site] by a URL rewriting

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unit which receives this URL of a web page upon a user's request, rewriting said second URL to be linked to said first URL. However, in the same field of electronic commerce, Lee discloses a URL rewriting unit which receives a second URL of a web page upon a user's request, rewriting said second URL to be linked to said first URL (see at least paragraph 0006). In view of Lee, it would be obvious to one of an ordinary skilled in the art to modify Palcic to incorporate the feature of URL rewriting because (a) to monitor and collect data on the user's behavior, as demonstrated in Lee and (b) the well-known feature of URL rewriting will enable a user to return to a web page without having to login again as the session id is passed from Web page to page.

Palcic discloses a history database for storing deal information relating a deal performed by the user on said web page having said second URL (see transaction database "500" in figures 1, 2, 3, 4 and 5), and

a compensation-granting unit for granting compensation relating the deal performed by the user on said web page having second URL based on the deal information stored in the history database (see at least paragraphs 0062-0063, "800" in figs 1 and 6. Unit 800 calculates the reward/compensation for each of the purchases made by the user on the selected merchant web site).

Note: Palcic does not provide the same names, that is compensation granting database, history database and compensation granting unit but it provides the same structure, that is storing feature of the required links/URLs and transaction/deal information and functions such as of linking and calculating compensation related to the purchase deal by the user on the sail merchant website.

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Regarding claim 38, its limitations are closely parallel to the limitations of claim 37 and therefore it is analyzed and rejected on the basis of same rationale as set forth in claim 37 above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 7043455 to Cuomo et al. discloses URL rewriting unit (see at least col.2, lines 1-3, col.5, lines 43-45 and col.7, lines 59-62).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

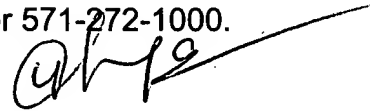
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Yogesh C Garg
Primary Examiner
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YCG
6/17/2007